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| 10/050,648      | 01/16/2002  | Dave Hamilton        | 3992P004X           | 8623             |

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EXAMINER

LIPMAN, JACOB

ART UNIT PAPER NUMBER

2134

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/050,648

Applicant(s)

HAMILTON ET AL.

Examiner

Jacob Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-17, 22-26, 33-37 and 42-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 5-8, 18-21, 27-32 and 38-41 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/18/02, 3/10/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-26 and 33-46, drawn to a system to identify a device, classified in class 726, subclass 7.
  - II. Claims 27-32, drawn to a system to identify a user, classified in class 713, subclass 182.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as identifying a user on a device. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Should applicant choose group I an election of species is necessary. This group contains claims directed to the following patentably distinct species of the claimed invention:

- I. Claims 5, 18, and 38, drawn to authentication to update dates.
- II. Claims 6-8, 19-21, and 39-41, drawn to authentication to unlock memory.
- III. Claims 9-13, 22-26, and 42-46, drawn to authentication to purchase or rent an asset.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4, 14-17, and 33-37 are generic in group I.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. A telephone call was made to Eric T. King on 15 September 2005 to request an oral election to the above restriction requirement, Mr. King elected group I and species III, claims 1-4, 9-17, 22-26, 33-37, and 42-46 without traverse.

#### ***Information Disclosure Statement***

5. The examiner has considered the information disclosure statements (IDSs) submitted on 18 April 2002 and 10 March 2003.

#### ***Specification***

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 9-17, 22-26, 33-37, and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menezes et al., in Handbook of Applied Cryptography in view of Chandra, USPN 4,817,140.

With regard to claims 1, 14, 33, and 35, Menezes discloses a system to identify a security device (A) the security device storing a serial number and key (page 401, paragraph starting 9798-2) and a server (B) storing the same serial number (parties are aware of claimed identity) and key (symmetric key), where when the device authenticates itself, the server request the device serial number (claimed identity), if there is a symmetric key associated with serial number, the server computes a challenge and the expected response (page 401, unilateral authentication using random numbers, steps 1 and 2), send the challenge to the device (step 1) and if the response matches the expected response authentication the device (page 401 paragraph starting B decrypts). Menezes does not disclose the device being a security device coupled to a computer. While Menezes' system is likely being run on a computer, it is not specifically stated. Chandra discloses a software distribution system (column 3 lines 22-51), in which software can be distributed over a network (column 3 lines 52-55), and securely run using a secure processor (column 3 lines 55-63) attached to the PC (column 3 lines 64-68). It would have been obvious to one of ordinary skill in the art to use

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authentication method of Menezes to authenticate the secure processor of Chandra when distributing software, to prevent unauthorized distribution, as Chandra discloses is optimal (column 3 lines 64-66).

With regard to claims 2, 15, and 34, Chandra discloses the keys are stored in a secure memory (column 11 lines 55-59).

With regard to claim 3, 16, and 36, Chandra discloses the device comprises a microprocessor (column 11 line 59).

With regard to claim 4, 17, and 37, Menezes discloses the challenge can be hashed (page 402).

With regard to claim 9, 22, and 42, Chandra discloses the asset being encrypted (column 3 lines 55-57) with an asset key (column 3 lines 60-63).

With regard to claims 10, 12, 23, 25, 43, and 45, Chandra discloses the asset key being encrypted with the key stored in the secure memory (column 24 lines 8-14) and being decrypted with it.

With regard to claim 11, 24, and 45, Menezes in view of Chandra discloses the limitations of claim 10, as outlined above, but do not mention that the software can be sold on a temporary basis. The examiner takes official notice that software is often sold on a trial basis, and expiration dates are often included. It would have been obvious for one of ordinary skill in the art to include an expiration date in the asset of Chandra to allow users trials, and increase sales.

With regard to claim 13, 26, and 46, Chandra discloses the asset is decrypted with the asset key by the secure memory (column 12 lines 1-12).


***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 571-272-3837. The examiner can normally be reached on M-Th 7 AM-3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL

  
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